

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 5-2-03

APPL. S.N.: 09/851223

EXAMINER: Katia Furt

ART UNIT: 1745

PARALEGAL: DEBBIE THOMAS

MAILROOM DATE: 9-24-03

AFTER FINAL: YES NO ✓

NUMBER OF T.D.(S) FILED: 1

INSTRUCTIONS: I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please see our Special Program Examiner or me.

THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.

The T. D. is PROPER and has been recorded. (See 14.23)

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)

The recording fee of \$ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)

Application Examiner has not processed fee for T. D.

The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)

The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)

T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)

The person who signed the terminal disclaimer:

has failed to state his/her capacity to sign for the business entity. (See 14.28)

is not recognized as an officer of the assignee. (See 14.29.1)

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72) NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)

No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)

The T. D. is not signed (See 14.26 and 14.26.3)

Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.

The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)

The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)

The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)

Other _____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Surampudi et al. Art Unit : Unknown
 Serial No.: not yet assigned Examiner : Unknown
 Filed : June 13, 2001
 Title : ORGANIC FUEL CELL METHODS AND APPARATUS

Commissioner for Patents
 Washington, D.C. 20231

TERMINAL DISCLAIMER UNDER 37 CFR §§3.73(b) AND 1.321(b)

Pursuant to 37 CFR §3.73(b), CALIFORNIA INSTITUTE OF TECHNOLOGY certifies that it is the assignee of the entire right, title, and interest in the above application by virtue of an assignment from the inventors of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel 6921, Frame 0845 on January 10, 1994. California Institute of Technology also certifies that it is the assignee of U.S. Patent No. 5,599,638. A copy of the assignment is attached for your reference.

The undersigned has reviewed all the documents in the chain of title of the above-identified application and to the best of undersigned's knowledge and belief, title is in California Institute of Technology.

The undersigned is empowered to act on behalf of the assignee.

Pursuant to 37 CFR §1.321(b), and to obviate a double patenting rejection, California Institute of Technology hereby

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. EL584937818US

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Post Office to Addressee with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

June 13, 2001

Date of Deposit

Signature

Gildardo Vargas

Typed or Printed Name of Person Signing Certificate

05/01/2003 FALLEN 09801228
 00000007 061050
 55.00 CH
 01 FC:2814

Applicant : Surampudi et al.
Serial No. :
Filed : January 30, 2001
Page : 2

Attorney's Docket No.: 06816-005003 / CIT 2209-D1

waives and disclaims the terminal portion of the term of the entire patent to be granted upon the above-identified application subsequent to the expiration date of U.S. Patent No. 5,599,638. Further, any patent granted on the above-identified application shall be enforceable only for and during such period that said patent is commonly owned with U.S. Patent No. 5,599,638.

California Institute of Technology does not disclaim any terminal part of any patent granted on the above identified application prior to the expiration date of the full statutory term of U.S. Patent No. 5,599,638 in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321, has all claims cancelled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title as stated above.

This disclaimer runs with any patent granted on the above application and is binding upon the grantee, its successors or assigns.

Please charge any additional fees, or make any credits, to Deposit Account No. 06-1050, referencing Attorney Docket No. 06816-005003.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may

Applicant : Surampudi et al.
Serial No. :
Filed : January 30, 2001
Page : 3

Attorney's Docket No.: 06816-005003 / CIT 2209-D1

jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date: _____


Scott C. Harris
Reg. No. 32,030

Fish & Richardson P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, CA 92122
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

10115653.doc